



4-12-04

16358

Attorney Docket No. 15240.096

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Title: METHODS OF GENE SILENCING
USING INVERTED REPEAT
SEQUENCES

Inventor: Gutterson, et al.

Serial No.: 09/924,197

Filing Date: August 7, 2001

Confirmation No.: 2170

Examiner: Lacourciere, Karen A.

Art Unit: 1635

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Office Action dated October 8, 2003, the period for response to which has been extended to April 8, 2004 by the filing herewith of a petition for a five-month extension of time and payment of the appropriate fee. Also submitted herewith is an Information Disclosure Statement, as well as a new Power of Attorney and Change of Correspondence Address. Please direct all future correspondence regarding this application to the undersigned.

The Office Action requires election between the following allegedly distinct and independent inventions:

- o Group I-Claims 1-27, drawn to methods of reducing expression of a target gene in a cell; and
- o Group II-Claims 28-53, drawn to specific expression cassettes.

In response to the restriction requirement, Applicant elects with traverse to prosecute Group I, Claims 1-27, directed to a method of reducing expression of a target gene in a cell.

Applicant has carefully considered this requirement, and most respectfully requests that it be withdrawn, for the reasons discussed below.

The Office Action acknowledges that the method/process invention of Group I, containing Claims 1-27 (directed to methods of using a specific expression cassette), is related to the product invention of Group II, containing Claims 28-53 (directed to a specific expression cassette). The Office Action states that the present inventions can be shown to be distinct if the process for using the product can be practiced with another materially different product, or if the product as claimed can be used in a materially different process of using that product. The Office Action goes on to urge that the expression cassette vector of Group II can be used in a materially different method of use other than the presently claimed method of reducing gene expression as set forth in the claims of Group II. However, there is no evidence of record indicating that the expression cassette of claims 28 et seq. could be used in any other method besides that set forth in claims 1-27. For example, with respect to method claim 4, Applicant notes that other than to specifically silence a gene comprising the 3'UTR itself, there would appear to be no use for the expression cassette of claim 31. Thus, the present method claims of Group I are not sufficiently distinct from the expression cassette claims of Group II such as to support a basis for restriction.

Further, MPEP Section 806.04 states that in order for claims to define independent inventions, the inventions must not be connected in design, operation or effect under the disclosure in the specification. As indicated above, all of the claims are related as they are directed to a very specifically defined method of reducing expression of a target gene in a cell, using the very specific constructs set forth in the claims of Group II. Thus, the claims of Group I and II are not sufficiently independent so as to support a restriction requirement between them.

**Response to Restriction Requirement
U. S. Patent Application No. 09/924,197**

In order to make a proper restriction requirement, an Examiner must show that the inventions sought to be restricted are both independent and distinct. This burden has not been met.


Applicant also notes that the Office Action indicates that the Group I claims are classified in Class 435/subclass 6, and that the Group II claims are classified in Class 536/subclass 24.5. It is most respectfully submitted that it is not an undue burden for the Patent Office to search in two subclasses in order to examine the claims of both groups.

In summary, reconsideration and withdrawal of the restriction requirement is most respectfully requested.

The Examiner is invited to telephone Applicant's undersigned representative if she believes that this would facilitate prosecution of the application.

Dated: April 8, 2004

Respectfully submitted,

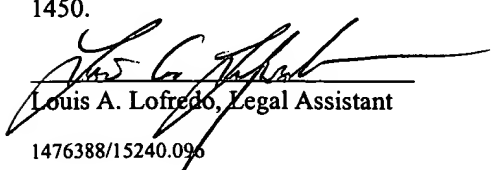

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I hereby certify that this paper and all documents and any fee referred to herein are being deposited on the date indicated above with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, postage prepaid and addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Louis A. Lofredo, Legal Assistant

4-08-04
Date of Signature